

REMARKS

Claims 1-10 are pending.

In the Office Action Summary, the Examiner indicates that claims 1-10 are pending and that claims 1, 3-5 and 7-10 are rejected. The Examiner states that claims 2 and 6 are withdrawn from consideration, but Applicant respectfully questions whether this is correct. In responding to the election of species requirement, Applicant had stated that claims 1, 2, 4, 5, 6, 8, 9 and 10 read on the elected species.

Expansion of Search

At page 2 of the Action, the Examiner acknowledges Applicant's election without traverse "in that claims 1, 2, 4, 5, 6 and 8-10 are read on the elected species."

The Examiner then states that Applicant is correct in stating that the references "do not disclose the claimed formula (Y-1)." Therefore, the Examiner states, "the search is further expanded to non-elected species such as (Y-3) in that claims 1, 3, 4-5, and 7-10 are read on the elected species."

With due respect, Applicant does not understand why the Examiner now excludes claims 2 and 6 from the scope of the subject matter that has been considered and searched. In addition, it is noted that claims 2 and 6 are not rejected based on the prior art. It therefore appears to Applicant that claims 2 and 6 should not be withdrawn from consideration, as indicated in the Summary of Action. Rather, they should be allowed. Allowance of claims 2 and 6 is respectfully requested.

Response to Section 103 Rejection of Claims 1, 3-5 and 7-10

At page 2 of the Action, claims 1, 3-5 and 7-10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lau et al '421 or '733, both of record.

Applicant submits that this rejection should be withdrawn because Lau et al '421 and '733 do not disclose or render obvious the insulating film-forming material of the present invention.

In the Response filed November 22, 2005, Applicant explained that the Lau et al '421 and '733 patents do not disclose repeating units within the scope of formula (Y-1) of present claim 1. See page 1 of the Response. The Examiner agrees, see page 2 of the present Action, and now focuses on repeating unit (Y-3) of present claim 1.

However, as explained at page 2 of the Response filed November 22, 2005, Lau et al '421 and '733 do not disclose repeating unit (Y-3) either. The upper two benzene rings in repeating unit (Y-3) of present claim 1 are substituted by the aromatic ring-containing monovalent hydrocarbon groups Rar_1 and Rar_2 . These substitutions are not disclosed or suggested in the Lau et al patents.

The gist of the Examiner's reasoning in support of the rejection is found in the first two paragraphs on page 3 of the Action. The Examiner's reasoning, particularly in the second paragraph on page 3, is insufficient to support the rejection, from a legal standpoint.

The Examiner concedes that the references differ from the present claims in that, inter alia, they do not disclose that "the upper two benzene rings in the repeating unit (Y-3) are substituted by the aromatic ring containing monovalent hydrocarbon groups Rar_1 and Rar_2"

The Examiner then reasons as follows:

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“However, the references do disclose similar reactants in that the hydrocarbon groups Rar1 and Rar2 do not effect [sic, affect] the mechanism to form the same or similar products. Therefore, it would have been obvious . . . to select Y-3 from the references within the limitation of the instant claims, to omit Rar1 and Rar2 from Y-3 and its function and employed the composition as claimed since the omission of an element and loss of its function from a combination is obvious in the absence of a showing of unexpected result[s] following from such omission.”

The Examiner appears to be saying that we can forget about the substituents Rar1 and Rar2 on the upper two benzene rings in (Y-3) and pretend that they do not exist. This is simply incorrect from a legal standpoint. The references must render the claimed composition -- not some modification of it -- obvious, and, in the present case, they do not. There is nothing in the references which would motivate one skilled in the art to modify their structures to include the required aryl-containing substituents Rar1 and Rar2 found in (Y-3) of the present invention.

With due respect, the cases the Examiner cites have no application here. In re Wilson involved removing a reactant (water) from a reaction mixture, not removing a substituent from a molecule. And Ex parte Rainu is not even a chemical case. The invention in Rainu was a hydroplane float. The Rainu case is irrelevant to the present situation.

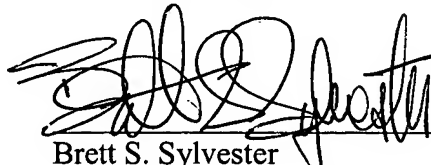
In view of the above, reconsideration and withdrawal of the §103(a) rejection based on Lau '421 or '733 are respectfully requested.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

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